



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)
Hanns-Joerg Mauk et al.) Examiner: Simone, Catherine A.
Serial No.: 10/725,117) Art Unit: 1772
Filed: December 2, 2003) Confirmation No.: 3331
For: RESILIENT FLOOR COVERING) Customer No.: 00112
WITH REGENERATIVE, DIRT-) Docket No.: 0324
REPELLENT SURFACE)

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

This brief is submitted pursuant to 37 CFR 1.192 in support of the Notice of Appeal filed May 24, 2006, in the above-identified application. A request for a one-month extension of time to August 24, 2006, and payment of the fee are included in the transmittal letter, filed herewith.

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Appl. No. 10/725,117
Appeal Brief Dated August 23, 2006
Response to Advisory Action Dated June 8, 2006

REAL PARTY IN INTEREST

The real party in interest in this application is Armstrong World Industries, Inc., the assignee of the present application.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, or Appellants' legal representatives, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending Appeal.

STATUS OF CLAIMS

Claims 1, 3 to 5, 7 to 10, 12 to 14, 16, 19, 20, 23, 26 and 28 to 34 are pending in the application. All of the claims are rejected. Claims 2, 6, 11, 15, 17, 18, 21, 22, 24, 25 and 27 are canceled.

Appl. No. 10/725,117
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STATUS OF AMENDMENTS

The Amendment and Response, filed on November 9, 2005, was entered. Therefore, the claims are as they appear in the November 9, 2005, response.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention concerns a resilient floor covering with improved dirt-repellent surface and improved wear resistance. The invention particularly concerns a resilient floor covering with a matrix or binder based on natural and/or synthetic materials, containing at least one substance incompatible with the matrix or binder. The resilient floor covering according to the invention is characterized by improved soiling behavior and increased wear resistance. See paragraphs 0002 and 0014.

Support for each element of claims 1, 3, 9, 26 and 28 to 30, the rejection of which is argued, is as follows:

Claim 1: A floor covering – title, paragraph 0002, 0013 to 0018, 0023 to 0028, 0030, 0031, 0033 to 0038, 0040, 0042, 0044, 0046, 0048 to 0050, 0053 to 0057 and 0059 to 0061, and the Abstract, for example.

Composition including a binder, a plasticizer and a substance capable of migration within the composition – paragraphs 0014, 0018, 0019, 0021, 0023, 0025, 0028, 0032, 0048 and 0061, and original claims 1 and 24, for example.

The binder comprising polyvinyl chloride (PVC) – paragraphs 0016, 0018, 0023, 0028 and 0032, for example.

The plasticizer in an amount of at least about 12 wt.% based on PVC – paragraphs 0019, 0028 and 0061, for example.

The substance capable of migration being present in an amount of from about 1.5 wt.% to about 15 wt.% based on the binder – paragraph 45, and original claims 11 and 24, for example.

Wherein the floor covering having a profile with elevations and recesses, the average spacing between profile peaks in the centerline being more than about 200 μm and less than about 1000 μm , and the difference in height between the elevations and the recesses being from about 20 μm to about 200 μm – paragraphs 0051 and 0052, and original claims 17 and 18, for example.

Claim 3: The floor covering according to Claim 26 – see claim 26 above.

The floor covering being homogenous – paragraph 0017 and original claim 3.

Claim 9: A floor covering – title, paragraph 0002, 0013 to 0018, 0023 to 0028, 0030, 0031, 0033 to 0038, 0040, 0042, 0044, 0046, 0048 to 0050, 0053 to 0057 and 0059 to 0061, and the Abstract, for example.

A layer having an exposed major surface – paragraphs 0015 and 0026, 0036, 0050, 0053 and 0055, for example.

The layer comprising a composition including a binder, a plasticizer and a substance capable of migration within the composition - paragraphs 0014, 0018, 0019, 0021, 0023, 0025, 0028, 0032, 0048 and 0061, and original claims 1 and 24, for example.

The binder comprising polyvinyl chloride (PVC) – paragraphs 0016, 0018, 0023, 0028 and 0032, for example.

The plasticizer being in an amount of at least about 12 wt.% based on PVC – paragraphs 0019, 0028 and 0061, for example.

The substance capable of migration being a wax-like substance comprising a plurality of wax-like substances and the wax-like substances having different melting points – paragraph 0042, and original claims 7 and 9, for example.

The amount of the substance capable of migration being in excess of its compatibility in the composition – Abstract, and original claims 1 and 24.

The substance capable of migration migrating to the exposed major surface – paragraphs 0015 and 0036, for example.

Claim 26: A floor covering – title, paragraph 0002, 0013 to 0018, 0023 to 0028, 0030, 0031, 0033 to 0038, 0040, 0042, 0044, 0046, 0048 to 0050, 0053 to 0057 and 0059 to 0061, and the Abstract, for example.

A composition including a binder, a plasticizer and a substance capable of migration within the composition – paragraphs 0014, 0018, 0019, 0021, 0023, 0025, 0028, 0032, 0048 and 0061, and original claims 1 and 24, for example.

Room temperature - paragraph 0015, for example.

The binder comprising polyvinyl chloride (PVC) – paragraphs 0016, 0018, 0023, 0028 and 0032, for example.

The plasticizer being in an amount of at least 12 wt.% based on PVC – paragraphs 0019, 0028 and 0061, for example.

The amount of the substance capable of migration being in excess of its compatibility in the composition – Abstract, and original claims 1 and 24.

Claim 28: The floor covering according to Claim 26 – see claim 26 above.

The substance capable of migration being a wax-like substance – paragraphs 0039 to 0041 and original claim 7.

Claim 29: The floor covering according to Claim 28 – see claim 28 above.

The wax-like substance being selected from the group consisting of a partially synthetic wax, a fully synthetic wax, a natural wax, a modified natural wax and mixtures thereof – paragraph 0041, and original claims 8 and 24.

Claim 30: The floor covering according to Claim 28 – see claim 28 above.

The wax-like substance comprising an amide wax – paragraphs 0036 and 0043, and original claim 10.

GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 7, 8, 10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kupitis US Patent No. 3,129,194 (“Kupitis”) in view of Eiden US Patent No. 4,336,293 (“Eiden”).

Claims 3 to 5, 13, 14, 23, 26 and 28 to 34 stand rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Claims 3, 4, 26 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Marchal US Patent No. 4,886,708 (“Marchal”).

Claims 3, 4, 13, 14, 23, 26 and 31 to 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hiragami.

Claims 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Marchal or Hiragami in view of Kondo et al. EP Patent Application No. EP 0 742 098 A1 (“Kondo”).

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either Marchal or Hiragami in view of Kondo and further in view of Apikos US Patent No. 3,518,215 (“Apikos”).

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either Marchal or Hiragami in view of Kondo.

ARGUMENT

In the Advisory Action mailed from the U. S. Patent and Trademark Office on June 8, 2006, the Primary Examiner maintained the rejection of all of the pending claims for the reasons of record.

Attorney for Applicants will argue separately the patentability of claims 1, 3, 9, 26 and 28 to 30. The remaining claims stand or fall with the claims from which they depend.

Section 103(a) Rejection of Claims 1, 7, 8, 10 and 12 over Kupitis in view of Eiden

The Examiner has maintained the rejection of claims 1, 7, 8, 10 and 12 as being obvious over Kupitis in view of Eiden in paragraph 4 on page 2 of the Office Action mailed January 24, 2006 ("the latest Office Action") for the reasons set forth in paragraph 7 on pages 4 and 5 of the Office Action mailed June 13, 2005. In paragraph 19 on pages 12 to 14 of the latest Office Action, the Examiner responded to the arguments filed on November 9, 2005.

In rejecting claims 1, 7, 8, 10 and 12 over Kupitis in view of Eiden, the Examiner looks to Eiden for a teaching of the floor covering having a profile with elevations and recesses with the average spacing between profile peaks in the centerline of more than about 200 μm and less than about 1000 μm , and the difference in height between the elevations and the recesses of from about 20 μm to about 200 μm , as required by claim 1.

In the Amendment and Response filed on November 9, 2005, Applicants argued the purpose of forming the elevations and recesses in Eiden (permitting drainage of liquids from the upper surface of the floor covering) is different than the purpose of the presently claimed elevations and recesses (to improve soiling behavior, i.e. improved dirt repellency, in a floor covering comprising a matrix or binder in combination with the substance capable of migration), and that optimizing the elevations and recesses of Eiden to improve drainage would not

necessarily yield the presently claimed ranges of spacing and height, which improve dirt repellency and therefore soiling behavior.

Below the middle of page 13 of the latest Office Action, the Examiner argues that “the elevations and recesses formed in the floor covering of Eiden improve the soiling behavior as well as permit drainage of liquids from the upper surface” since “the liquids being drained ... are *dirty* liquids such as grease, oil, water and the like.” (Italics in original.) While the Attorney for Applicants agrees that Eiden does teach a means of improving soiling behavior, the soiling behavior addressed by Eiden is not the soiling behavior of the present invention. One is directed to draining liquids and the other to repelling dirt.

Eiden is concerned about removing dirty liquids. The present invention is directed to repelling dirt from the surface with a substance that is incompatible with the matrix of the floor covering and that migrates to the surface of the floor covering. See paragraphs 0014 and 0015 of the specification. The elevations and recesses specified in claim 1 improve this dirt-repelling behavior. See paragraphs 0050 to 0053 of the specification.

Therefore, while both Eiden and the present invention are both directed to the general category of improving soiling behaviors, the soiling behaviors addressed are quite different and optimizing the conditions for the one does not optimize the conditions for the other. The optimized (preferred) ranges for spacing and height of Eiden fall outside the claimed ranges of present claim 1.

Near the top of page 14 of the latest Office Action, the Examiner states that “the optimum ranges for the spacing and the height of the elevations and recesses would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results.” However, since person having ordinary skill would be following the teachings of

Eiden, it is the purpose of Eiden that he would be optimizing. Unless that is some reason to contradict the teachings of Eiden, one must assume that optimizing the ranges of Eiden would yield his preferred difference in height between the elevations and the recesses of 1.3 to 2.0 mm and the spacing between peaks of 25 mm. Therefore, optimizing the ranges of Eiden through routine experimentation does not yield the ranges of present claim 1.

In the carryover paragraph on pages 2 and 3 of the Advisory Action mailed June 8, 2006 (“Advisory Action”), the Examiner argues “that the features upon which the applicant relies (i.e., “*repelling dirt from the surface* with a substance that is incompatible with the matrix of the floor covering and that migrates to the surface of the floor covering” and “the elevations and recesses...improve this dirt-repelling behavior”) are not recited in the rejected claims.” However, it is the specific average spacing and difference in height between the elevations and recess, which are set forth in the claims, upon which the Applicants rely to distinguish Eiden.

Attorney for Applicants argues that the teachings of Eiden lead one of ordinary skill to optimize the height and spacing between the elevations and recess to the preferred height and spacing taught by Eiden of 1.3 to 2.0 mm and 25 mm. This height and spacing falls outside the present claim limitations of about 20 μm to about 200 μm and more than about 200 μm and less than about 1000 μm .

The only way one of ordinary skill would optimize the heights and spacing to yield the presently claimed ranges would be if he were optimizing the dirt-repelling behavior taught in the present specification and not by optimizing the drainage of liquids from the upper surface taught in Eiden. While it is the purpose of the optimization which leads one of ordinary skill to the preferred profile of Eiden or the claimed profile of present claim 1, it is not necessary to include

the purpose in the claim. The profile set forth in present claim 1, distinguishes the profile resulting from optimizing the Eiden profile for the purpose of Eiden.

Without reference to the present specification, one of ordinary skill would optimize the profile of Eiden for the purpose taught by Eiden, i.e. draining liquids from the upper surface, which would lead one to a profile that falls outside the claimed ranges of claim 1. Therefore, claim 1 and claims 7, 8, 10 and 12, dependent thereon, are not obvious over Kupitis in view of Eiden.

35 U.S.C. 112, First Paragraph, Rejection of Claims 3 to 5, 13, 14, 23, 26 and 28 to 34

In paragraph 7 on page 3 of the latest Office Action, the Examiner takes the position that the phrase “at room temperature” is new matter and the specification, as filed, does not provide support. While the phrase “at room temperature” does not appear, *ipsis verbis*, in the specification, paragraph 0015, as filed, states

“at least one substance migrates slowly, but continuously from the floor covering to the surface of the floor covering and thus forms a continuously renewing protection, even when the substance migrating to the surface is worn or abraded off by walking on the floor covering.”

Or with ellipses, the “substance migrates ... continuously ... even when ... the surface is worn or abraded off by walking on the floor covering.” Since the floor covering is walked on at room temperature, the substance, which migrates continuously, migrates at room temperature and the phrase “at room temperature” is supported by the specification, as filed.

Near the top of page 4 of the Advisory Action, the Examiner maintains her position that “the phrase ‘at room temperature’ clearly does not appear in the specification and is not clearly supported by the specification, as originally filed. Therefore, the phrase ‘at room temperature’ in claim 26 is still deemed to be new matter.”

The phrase “at room temperature” does not have to appear in the specification. As held by the Court of Appeals for the Federal Circuit in Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 1000 (2000):

“If lack of literal support alone were enough to support a rejection under § 112, then the statement of *In re Lukach* ... that “the invention claimed does not have to be described *in ipsis verbis* in order to satisfy the description requirement of § 112,” is empty verbiage.

(Italics in original, citation omitted.) The concept of room temperature migration is adequately supported. The specification clearly teaches that the substance migrates while the floor covering is walked upon. The clear implication is that the floor covering is at room temperature. As held by the Court of Appeals for the Federal Circuit in *Smithkline Beecham Corp. v. Excel Pharmaceuticals, Inc.*, 356 F.3d 1357, 1364 (2004):

“The new matter doctrine prevents an applicant from adding new subject matter to the claims unless the specification shows that the inventor had support for the addition at the time of the original filing.”

(Citation omitted.) Clearly Applicants were in possession of the concept of a substance that migrates at room temperature. Therefore, the rejection under Section 112 of claim 26 and claims 3 to 5, 13, 14, 23 and 28 to 34, dependent thereon, has been overcome.

Section 102(b) Rejection of Claims 3, 4, 26 and 31 over Marchal

The Examiner has maintained the rejection of claims 3, 4, 26 and 31 as being anticipated by Marchal in paragraph 9 on pages 3 and 4 of the latest Office Action. The Examiner takes the position that column 3, lines 20 to 25 and 65 to 68, of Marchal teach the plasticizer to be in an amount of at least 12 wt% based on PVC, as required by claim 23. However, the cited passages only teach that 100 parts of PVC plastisol is used in the examples. There is no teaching in Marchal as to what the plasticizer content in the plastisol is.

A reference can anticipate a claim limitation without specifically teaching the limitation, if the limitation is inherent. However, a plastisol does not inherently have at least 12 wt % plasticizer based on PVC as set forth in independent claim 26. See Wickson US Patent No. 4,656,214 (Wickson), which “relates generally to vinyl chloride plasticizers” (col. 1, lines 13 and 14). At col. 4, lines 49 to 54, Wickson states:

“The novel plasticizers of this invention have been found to provide plastisols and organosols of low viscosity, which is a very advantageous property for plastisols and organosols intended for use in the manufacture of vinyl sheet floorings.”

And at col. 11, lines 38 to 44:

“The amount of plasticizer employed with any resin system will vary widely based on specific desired properties and the resin system itself. However, the plasticizer may be employed in amounts ranging from about 1 to 200 parts of plasticizer per hundred parts of resin by weight (phr) and preferably 10 to 100 phr.”

(Emphasis supplied.) The “at least 12 wt.% based on PVC” of claim 26 equals at least 12 phr. Therefore, Marchal does not anticipate claim 26 or claims 3, 4 or 31, which depend on claim 26.

Further, with regard to claim 3, the Examiner indicates that column 1, lines 8 to 12, of Marchal teaches a homogenous floor covering. The cited passage states that the “invention relates to a process for the manufacture of plastisol based synthetic coverings (e.g., floor or wall coverings) having improved resistance to soiling.” This does not teach a homogenous floor covering, only that the floor covering includes a plastisol. As clearly taught at column 1, lines 33 to 44 and 62 to 66, of Marchal:

The present invention also provides a synthetic covering having a plastisol based wear layer ... deposited on a conventional support.”

Also see column 2, lines 35 to 40, and claim 13. Therefore, claim 3 is allowable over Marchal for this reason as well.

Section 102(b) Rejection of Claims 3, 4, 13, 14, 23, 26 and 31 to 34 over Hiragami

The Examiner has maintained the rejection of claims 3, 4, 13, 14, 23, 26 and 31 to 34 as being anticipated by Hiragami in paragraph 10 on pages 4 and 5 of the latest Office Action. The Examiner indicates that the amount of the substance capable of migration being in excess of its compatibility in the composition is taught at column 3, lines 19 to 22 and 32 to 45, of Hiragami. However, these passages discuss “the particles [being] highly compatible with the matrix layer,” the “particles [being] dispersed or distributed throughout the entire thickness of the matrix layer, so that even when the matrix layer gradually wears, internal particles become exposed in succession” and “the particles exhibit[ing] good compatibility with the matrix layer during processing.” There is no teaching or suggestion in the cited passages or anywhere else Hiragami of the particles or any other component migrating.

In the carryover paragraph on pages 4 and 5 of the Advisory Action, the Examiner states that “it is to be pointed out that it has been held that a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform.” First, the Examiner has not supplied support for this assertion. Attorney for Applicants has found a number of Federal Circuit cases that treat an element being capable of as a positive limitation, including **Prima Tek II, L.L.C. v. Polypap, S.A.R.L.**, 412 F.3d 1284, 1288 (C.A.Fed., 2005); **Goldenberg v. Cytogen, Inc.**, 373 F.3d 1158, 1169 (C.A.Fed., 2004); and **Arlington Industries, Inc. v. Bridgeport Fittings, Inc.**, 345 F.3d 1318, 1324 (C.A.Fed., 2003).

To meet such limitation, it may not be necessary to show that substance actually migrates, but there must be a teaching or suggestion that the substance has the ability to migrate. This the Examiner has not done. The Examiner has failed to show where in Hiragami or elsewhere there is a teaching or suggestion that the particles of Hiragami have the ability to

migrate in the floor material of Hiragami at room temperature as required by claims 3, 4, 13, 14, 23, 26 and 31 to 34.

The particles of Hiragami are exposed to the surface by the wearing away of the surface material, not by the particles migrating to the surface. See col. 3, lines 34 and 35 (“when the matrix layer gradually wear, internal particles become exposed in succession”). Being exposed by having the surrounding resin wore away is not migration. Therefore, claim 26 and claims 3, 4, 13, 14, 23 and 31 to 34, dependent thereon, are allowable over Hiragami.

Further, with regard to claim 3, the Examiner indicates that column 1, lines 57 to 68, of Hiragami teaches a homogenous floor covering. However, the cited passage discusses a “polyvinyl chloride matrix layer” and not a homogenous floor covering. See the Figure and column 3, lines 6 to 9, of Hiragami where the PVC matrix layer 1 overlies the backing 3.

Near the top of page 5 of the Advisory Action, the Examiner states “according to *Merriam-Webster’s Collegiate Dictionary, tenth edition*, ‘homogenous’ is defined as ‘homogeneous’ which is defined as ‘of uniform composition or structure throughout’. The floor covering in Hiragami is made up of a PVC matrix layer, which is of uniform composition throughout, (see col. 1, lines 57-68) and is therefore homogenous. Thus, Hiragami clearly teaches a homogenous floor covering.” (Italics in original.)

Attorney for Applicants concedes that the Hiragami PVC layer is homogenous. However, present claim 3 requires the floor covering and not merely the PVC layer to be homogenous. Attorney for Applicants maintains that Hiragami teaches a homogenous PVC layer 1 overlying a backing 3. Since, there is no teaching or suggestion in Hiragami of the PVC layer 1 being of the same composition as the backing 3, the floor covering of Hiragami is not homogenous as required by claim 3. If the Examiner disagrees, she is respectfully requested to

explain where in the cited art there is a teaching or suggestion of a homogenous floor covering, or if the rejection is based on facts within the personal knowledge of the Examiner, support in the form of an affidavit is requested, in accordance with MPEP section 707.

Col. 1, lines 57 to 68, of Hiragami teaches “the floor material comprises a polyvinyl chloride matrix layer having dispersed therein throughout its entire thickness synthetic resin particles.” (Emphasis supplied.) Rather than teach a homogenous floor covering, it teaches a homogenous PVC layer as one component of a floor covering, i.e. a non-homogenous floor covering. Therefore, claim 3 is allowable over Hiragami for this reason as well.

Section 103(a) Rejection of Claims 28 and 29 over Marchal or Hiragami in view of Kondo

The Examiner has maintained the rejection of claims 28 and 29 in paragraphs 13 and 14 on pages 6 and 7 of the latest Office Action as being obvious over either Marchal or Hiragami in view of Kondo. The Examiner relies on Marchal and Hiragami for the teachings discussed above. Therefore, claims 28 and 29 are allowable for the reasons discussed above with regard to claim 26.

Further, the Examiner relies on Kondo for a teaching that it is old and well-known to use wax-like substances in a surface layer of a floor covering for the purpose of improving lubricity as well as flaw resistance, stain resistance and abrasion resistance. However, Kondo does not teach or suggest that the wax-like substances migrate at room temperature.

At the middle of page 6 of the Advisory Action, the Examiner states that “Kondo clearly teaches the wax-like substances migrating at room temperature (see page 4, lines 11-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the [applicants’ (sic)] invention was made to have modified the substance capable of migration in the

wear layer of the floor covering in either Marchal or Hiragami to be a wax-like substance selected from the group consisting of a partially synthetic wax, a fully synthetic wax, a natural wax, a modified natural wax and mixtures thereof as suggested by Kondo et al. in order to improve lubricity as well as flaw resistance, stain resistance and abrasion resistance.”

However, the cited passage of Kondo states:

“the surface is slightly rubbed down and a new polished surface with dispersed wax is exposed when polished with a buffing machine.”

(Emphasis supplied.) Rubbing down the surface to expose a new surface does not teach or suggest the particles migrating, but rather removing a portion of the wax to expose the particles. Again, the Examiner has failed to point out where in Kondo there is a teaching or suggestion of the particles migrating. Therefore, claims 28 and 29 are allowable for this reason as well.

Section 103(a) Rejection of Claim 30 over Marchal or Hiragami in view of Kondo and further in view of Apikos

The Examiner has maintained the rejection in paragraph 15 on page 8 of the latest Office Action of claim 30 as being obvious over either Marchal or Hiragami in view of Kondo and further in view of Apikos. The Examiner relies on Marchal, Hiragami and Kondo for the teachings discussed above. Therefore, claim 30 is allowable for the reasons discussed above with regard to claims 26, 28 and 29.

Further, the Examiner relies on Apikos for a teaching that it is old and well-known to have an amide wax as the substance capable of migration in a surface layer for the purpose of providing temporary surface protection against abrasion, dirt and other damage occurring in storage and handling. See the carryover paragraph on pages 6 and 7 of the Advisory Action. However, the invention of Apikos is directed to

“[s]trippable coatings ... wherein it is desirable to provide temporary surface protection against abrasion, rust, dirt and other damage occurring in storage and handling.”

(Column 1, lines 29 to 32.) As defined by Apikos at col. 1, lines 35 to 37, strippable coatings are:

“compositions which may be deposited as coating upon a surface and thereafter removed as essentially continuous films.”

(Emphasis supplied.) It is the strippable coating and not the amide that provides the protection.

“The concentration [of the amide] must be sufficient to impart strippability without completely destroying the bond between the surface and the coating.”

(Column 2, lines 38 to 41.) The purpose of the amide is to provide strippability of the coating and not stain and dirt resistance. It would not be obvious to substitute the amide wax of Apikos for the particles of Marchal or Hiragami, since neither Marchal nor Hiragami are directed to strippable coatings, i.e. removable, substantially continuous films. Therefore, claim 30 is allowable over the combination with Apikos for this reason as well.

Section 103(a) Rejection of Claim 9 over Marchal or Hiragami in view of Kondo

The Examiner has maintained the rejection of claim 9 as being unpatentable over either Marchal or Hiragami in view of Kondo in paragraphs 17 and 18 on pages 10 to 12 of the latest Office Action. As discussed previously, there is no teaching in Marchal as to what the plasticizer content in the plastisol is or in Hiragami of any component migrating. There is no teaching in Kondo of the wax migrating. To the contrary, at page 4, lines 11 to 13, Kondo teaches that

“When a wax is contained in the surface layer 1 in this way, the wax is exposed on the surface in a dispersed state so that a polished surface gloss is obtained. Also, even when the surface gloss of the surface layer 1 is reduced due to walking and the like, the surface is slightly rubbed down and a new polished surface with dispersed wax is exposed.”

Therefore, rather than the wax migrating to the surface, Kondo teaches wearing down the surface layer to expose additional wax that has been dispersed in the surface layer. Therefore, claim 9 is allowable for these reasons.

Claims 1, 3, 9, 26 and 28 to 30 are patentable for the reasons discussed above. Claims 4, 5, 7, 8, 10, 12 to 14, 16, 19, 20, 23 and 31 to 34 depend directly or indirectly from independent claims 1, 9 or 26 and are allowable, since claims 1, 9 and 26 are allowable. Accordingly, claims 1, 3 to 5, 7 to 10, 12 to 14, 16, 19, 20, 23, 26 and 28 to 34 should be found allowable. Reversal of the rejections is respectfully requested.

Respectfully submitted,

8/23/06
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Glenna K. Wilkey

CLAIMS APPENDIX

Pending Claims

1. A floor covering comprising a composition including a binder, a plasticizer and a substance capable of migration within the composition, wherein the binder comprises polyvinyl chloride (PVC), the plasticizer is in an amount of at least about 12 wt.% based on PVC, and the substance capable of migration is present in an amount of from about 1.5 wt.% to about 15 wt.% based on the binder, and wherein the floor covering has a profile with elevations and recesses, the average spacing between profile peaks in the centerline is more than about 200 μm and less than about 1000 μm , and the difference in height between the elevations and the recesses is from about 20 μm to about 200 μm .

3. The floor covering according to Claim 26, wherein the floor covering is homogenous.

4. The floor covering according to Claim 26, wherein the floor covering is multilayered.

5. The floor covering according to Claim 26, wherein the PVC has a K-value from about 40 to about 80.

7. The floor covering according to Claim 1, wherein the substance capable of migration is a wax-like substance.

8. The floor covering according to Claim 7, wherein the wax-like substance is selected from the group consisting of a partially synthetic wax, a fully synthetic wax, a natural wax, a modified natural wax and mixtures thereof.

9. A floor covering comprising a layer having an exposed major surface, the layer comprising a composition including a binder, a plasticizer and a substance capable of migration within the composition, wherein the binder comprises polyvinyl chloride (PVC), wherein the plasticizer is in an amount of at least about 12 wt.% based on PVC, wherein the substance capable of migration is a wax-like substance comprising a plurality of wax-like substances, the wax-like substances having different melting points, and wherein the amount of the substance capable of migration is in excess of its compatibility in the composition, whereby the substance capable of migration migrates to the exposed major surface.

10. The floor covering according to Claim 7, wherein the wax-like substance comprises an amide wax.

12. The floor covering according to Claim 1, wherein the floor covering further comprises a substrate and a coating, the coating comprising the binder, plasticizer and substance capable of migration.

13. The floor covering according to Claim 31, wherein the coating has a thickness of about 10 μm to about 100 μm .

14. The floor covering according to Claim 31, wherein the substrate comprises the same PVC as the PVC of the coating.

16. The floor covering according to Claim 12, wherein the coating comprises a particulate material having a hardness greater than the hardness of the PVC of the coating.

19. The floor covering according to Claim 1, wherein the composition comprises a particulate material having a hardness greater than the hardness of the PVC.

20. The floor covering according to Claim 19, wherein the particulate material comprises a polymer.

23. The floor covering according to Claim 33, wherein a plurality of the particles of the particulate material protrude above the surface of the PVC.

26. A floor covering comprising a composition including a binder, a plasticizer and a substance capable of migration within the composition at room temperature, the binder comprising polyvinyl chloride (PVC), the plasticizer being in an amount of at least 12 wt.% based on PVC, and the amount of the substance capable of migration being in excess of its compatibility in the composition.

28. The floor covering according to Claim 26, wherein the substance capable of migration is a wax-like substance.

29. The floor covering according to Claim 28, wherein the wax-like substance is selected from the group consisting of a partially synthetic wax, a fully synthetic wax, a natural wax, a modified natural wax and mixtures thereof.

30. The floor covering according to Claim 28, wherein the wax-like substance comprises an amide wax.

31. The floor covering according to Claim 26, wherein the floor covering further comprises a substrate and a coating, the coating comprising the binder, plasticizer and substance capable of migration.

32. The floor covering according to Claim 31, wherein the coating comprises a particulate material having a hardness greater than the hardness of the PVC of the coating.

33. The floor covering according to Claim 26, wherein the composition comprises a particulate material having a hardness greater than the hardness of the PVC.

34. The floor covering according to Claim 33, wherein the particulate material comprises a polymer.

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None